UNITED STATES PATENT AND TRADEMARK OFFICE

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10/588,238	04/18/2007	Yoshinari Endo	FUJ1 188NP	5424

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 January 2009</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

The instant application having Application No. 10/588,238 is presented for examination by the examiner. Claims 1-19 have been amended. Claim 20 has been added. Claims 1-20 remain for examination.

Response to Amendment

In the previous office and Examiner relied upon a machine translation of JP 2001-218030 in rejecting the claims. Examiner supplied Applicant with a copy of the machine translation. As a courtesy and for clarity, Examiner had a human English translation conducted on the Japanese patent. Examiner has found the human translation to be clearer and easier to understand. Examiner is also attaching a copy of this translation for Applicant's convenience.

Specification

The amendments to the title and abstract have overcome the previous objection.

Drawings

The substitute drawing is accepted.

Claim Objections

Claims 10-15,18,19 are objected to because of the following informalities:

Claims 10-15, 18, and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 10 does not further limit the image information processing apparatus of claim 1 from which it depends. To be a proper dependent claim it must limit the scope of the parent claim. Disclosing a system which contains the apparatus of claim 1 does not further narrow the scope of the apparatus of claim 1. This type of hybrid claim is not permissible in US Patents.

Claims 11-13 and 18 should further limit the apparatus disclosed in claim 1.

Claims 14, 15, and 19 are objected to because of the same reason as claim 10 for failing to properly limit their parent claim.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Examiner is supplying a human translation of the Japanese Patent 2001-218030 to Oki for Applicant's convenience. In paragraph 0061 and 0062, Oki teaches the new limitation of the independent claim

where an image acquisition component acquires input image data fro ma printed

medium. In Oki's system a digital copier is able to read embedded copyright

information of a printed image and restrict illegal copies. As pointed out below in the

103 rejection, Examiner finds that one of ordinary skill, knowing the teachings of Oki,

would be motivated to incorporate the details of Oki into the copier to better protect

printed images. By doing so, the copier would generate new image information and

embed it into the copies to prevent illegal copies of copies from being made. Given the

suggestion of acquiring input image data from printed images, one of ordinary skill in the

art could extend the digital protection practices of Oki to printed material as well since it

is known how to read embedded copyright information from said printed materials.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Applicant has amended the term additional

information to the term image information. Examiner could not provide support in the

specification to define what this term means. The term seems like another way to

define image data. The term image data shows up throughout the claims. The claims

are rendered indefinite because Examiner cannot distinguish between image

information and image data. What are differences and where is the specification is the distinction address?

Claim 10-15,18,19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear what is trying to be claimed in these claims. These claims depend from claims directed to an apparatus. The claim matter is directed not only to the apparatus but also to a system. Why do the claims already redundantly redefine the apparatus when it is already defined in the parent claim? The scope and intent of the claims are both impossible to ascertain.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 10-13, 16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-218030 to Oki, hereinafter Oki.

As per claim 1, Oki teaches an image information processing apparatus comprising:

an image acquisition component which acquires input image data in which image

information is embedded (0018);

an extracting [analyzing] component which extracts the image information from the input

image data (0018); and

an image information modification component which generates new image information

by modifying the image information when determining that the image information

complies with a predetermined condition, and generates copied image data by

embedding the new image information into the input image data or image data obtained

by removing the image information from the input image data (0053-0054).

Oki teaches the process of storing data into printed images and acquiring data

from printed images in paragraphs 0062-0063. Oki teaches that copier machines can

be used to acquire data hidden in the picture and to conform to the embedded rights to

prevent illegal copying. Oki teaches the modification of the image information

limitations of the claim applied to digital data. Therefore, Oki teaches inputting image

information into printed media and acquiring that information to instruct the copier to

follow the permissions of the embedded data. It is then obvious that the printer driver

inside of the copier can carry out the processing of new image information. In fact, if it

couldn't modify or somehow change the information embedded into the copies, it could

not prevent copies of copies from being made. It would be obvious to one of ordinary

skill who wanted to implement this system into a digital printer/copier machine to extend

the functionality of Oki's digital file management to printed data as well. If a copier has

the functionality of modifying the embedded data of the copies from that of the original

(by carrying out the principles of Oki) the system could better protect data after its printed from illegal copying.

As per claim 2, Oki teaches said image information contains copy control information for limiting an allowable number of times the input image data is copied (0018); and

when determining that the copy control information contains a variable value representing permission to copy the input image data, said image information modification component generates the new image information by modifying the variable value and generates the copied image data (0054).

As per claim 3, Oki teaches said image information contains copy control information for limiting an allowable number of times the input image data is copied; and when determining that the copy control information contains a variable value representing permission to copy the input image data, said image information modification component generates the new image information by modifying the variable value and generates the copied image data (0054).

As per claim 10, Oki teaches a scanner which obtains the input image data by optically scanning a printed medium in which the image information is embedded; and a printer which prints out the copied image data (0012-0013).

As per claim 11, Oki teaches a data receiving unit which receives image data transmitted through a communication line and provides the received image data to the image acquisition component (0013).

As per claim 12, Oki teaches a data sending unit which sends the copied image data to said communication line (0013).

As per claim 13, Oki teaches a display unit which displays one or both of the image information extracted by said extracting component and the new image information (0014).

As per claim 18, Oki teaches a data sending unit which sends the copied image data to said communication line (0013).

As per claim 16, Oki teaches an image information processing method comprising the steps of:

(a) acquiring input image data in which image information is embedded (0018);

(b) extracting the image information from the input image data (0018);

(c) determining whether or not the extracted image information complies with a predetermined condition (0018); and

(d) generating new image information by modifying the image information when it is determined in said step (c) that the image information complies with said predetermined condition, and generating copied image data by embedding the new image information into the input image data or image data obtained by removing the image information from the input image data (0053-0054).

Oki teaches the process of storing data into printed images and acquiring data from printed images in paragraphs 0062-0063. Oki teaches that copier machines can be used to acquire data hidden in the picture and to conform to the embedded rights to prevent illegal copying. Oki teaches the modification of the image information

limitations of the claim applied to digital data. Therefore, Oki teaches inputting image

information into printed media and acquiring that information to instruct the copier to

follow the permissions of the embedded data. It is then obvious that the printer driver

inside of the copier can carry out the processing of new image information. In fact, if it

couldn't modify or somehow change the information embedded into the copies, it could

not prevent copies of copies from being made. It would be obvious to one of ordinary

skill who wanted to implement this system into a digital printer/copier machine to extend

the functionality of Oki's digital file management to printed data as well. If a copier has

the functionality of modifying the embedded data of the copies from that of the original

(by carrying out the principles of Oki) the system could better protect data after its

printed from illegal copying.

As per claim 20, Oki teaches the new image information is embedded to the

printed medium as a background pattern (0061).

Claims 4-9, 14, 15, 17, and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Oki in view of USP 6,664,976 to Lofgren et al., hereinafter Lofgren.

As per claim 4, Oki is silent in disclosing an image information modification

component modifies the variable value by a smaller amount with a higher level of

access authorization of a user, and modifies the variable value by a larger amount with

a lower level of the access authorization level of a user. Lofgren teaches an image

information modification component modifies the variable value by a smaller amount

with a higher level of access authorization of a user, and modifies the variable value by

a larger amount with a lower level of the access authorization level of a user (col. 9,

lines 1-25). Lofgren, which uses a granular access method to protected content,

teaches that users must meet certain authentication levels in order to access such

content. Lofgren uses bits in the watermarking to differentiate between access levels.

There is obvious some type of an order whereby only users with the most clearance can

access all the content. On the contrary, users with low clearance can only access the

less classified content. Such a teaching, obviously benefits Oki's system in which really

the only two types of protection for the content is the number of copies and number of

pages printed. The use of known technique to improve similar devices in the same way

is obvious to one of ordinary skill in the art. The claim would have been obvious

because the technique for improving watermarking copy prevention was part of the

ordinary capabilities of a person of ordinary skill in the art at the time of the invention, in

view of the teaching of granular user access levels in Lofgren.

As per claim 5, Oki teaches recording component which stores the image

information extracted by said extracting component (0018). Oki is silent in disclosing

when determining that the image information contains a flag value representing image

data of an original file and the same image information is not stored in said recording

component, said image information modification component generates the new image

information to write the generated new image information into the recording component

and generates the copied image data;

when determining that the image information contains a flag value representing the

image data of an original file and that the same image information is stored in said

recording component, said image information modification component modifies the

variable value that is contained within the image information stored in said recording

component, and generates the new image information and the copied image data; and

when determining that the image information contains a flag value not representing the

image data of an original file, said image information modification component does not

generate the copied image data. Lofgren teaches when determining that the image

information contains a flag value representing image data of an original file and the

same image information is not stored in said recording component, said image

information modification component generates the new image information to write the

generated new image information into the recording component and generates the

copied image data (col. 6, lines 39-40);

when determining that the image information contains a flag value representing the

image data of an original file and that the same image information is stored in said

recording component, said image information modification component modifies the

variable value that is contained within the image information stored in said recording

component, and generates the new image information and the copied image data (col.

6, lines 40-45); and

when determining that the image information contains a flag value not representing the

image data of an original file, said image information modification component does not

generate the copied image data (col. 6, lines 20-25). Each of these steps is a means to

handle particular types of content one is dealing with. There are three content types,

one for each respective clause. The first type is a new original document with a

watermarking. The second type is an original document with new image information.

And the third type is a non original type or copied. Lofgren system handles each of

these types of documents in a controlled system that prevents users who should not

have access to or modify such content. Again Lofgren's system adds more features

and provides a greater level of security than what is taught by Oki. Therefore one of

ordinary skill in the art would see these features as improvements to Oki's system.

Applying a known technique in a known way to a known device to yield predictable

results is obvious. Therefore the claim would have been obvious because a particular

known technique was recognized as part of the ordinary capabilities of one skilled in the

art.

As per claim 6, Oki is silent in disclosing determining that the image information

contains a flag value representing image data of an original file, said image information

modification component generates the new image information by changing the flag

value to a value not representing image data of an original file, and generates the

copied image data. Lofgren teaches determining that the image information contains a

flag value representing image data of an original file, said image information

modification component generates the new image information by changing the flag

value to a value not representing image data of an original file, and generates the

copied image data (col. 6, lines 40-45). Examiner relies upon the same rationale for

combining the teachings of Lofgren with the teachings of Oki as a means to improve on

the system of Oki as cited above.

As per claim 7, Oki is silent in disclosing determining that a level of access authorization of a user is equal to or larger than a predetermined level, said image information modification component can provide the copied image data having the same image information as that of the input image data, without generating the new image information. Lofgren teaches determining that a level of access authorization of a user is equal to or larger than a predetermined level, said image information modification component can provide the copied image data having the same image information as that of the input image data, without generating the new image information (col. 9, lines 1-17). Examiner relies upon the same rationale for combining the teachings of Lofgren with the teachings of Oki as a means to improve on the system of Oki as cited in the rejection of claim 4.

As per claim 8, Oki is silent in disclosing image information modification component generates the new image information by adding personal identification information of a user to the image information. Lofgren teaches image information modification component generates the new image information by adding personal identification information of a user to the image information (col. 4, lines 40-50 and col. 9, lines 64-67). Examiner relies upon the same rationale for combining the teachings of Lofgren with the teachings of Oki as a means to improve on the system of Oki as cited in the rejection of claim 4.

As per claim 9, Oki is silent in disclosing image information modification component generates the new image information by adding identification information of a system to the image information, said image information processing apparatus is

integrated in said system. Lofgren teaches image information modification component generates the new image information by adding identification information of a system to the image information, said image information processing apparatus is integrated in said system (col. 4, lines 40-50). Examiner relies upon the same rationale for combining the teachings of Lofgren with the teachings of Oki as a means to improve on the system of Oki as cited above.

As per claim 14, Oki is silent in disclosing an information reading unit which reads personal identification information from a recording medium storing the personal identification information of a user, and provides the read personal identification information to said image information processing apparatus. Lofgren teaches an information reading unit which reads personal identification information from a recording medium storing the personal identification information of a user, and provides the read personal identification information to said image information processing apparatus (col. 9, lines 40-45). Examiner relies upon the same rationale for combining the teachings of Lofgren with the teachings of Oki as a means to improve on the system of Oki as cited above.

As per claim 15, Oki is silent in disclosing an information reading unit which reads access authorization from a recording medium storing the access authorization of a user, and provides the read access authorization to said image information processing apparatus. Lofgren teaches an information reading unit which reads access authorization from a recording medium storing the access authorization of a user, and provides the read access authorization to said image information processing apparatus

(col. 9, lines 42-44). Examiner relies upon the same rationale for combining the teachings of Lofgren with the teachings of Oki as a means to improve on the system of Oki as cited above.

As per claim 17, Oki is silent in disclosing an image information modification component modifies the variable value by a smaller amount with a higher level of access authorization of a user, and modifies the variable value by a larger amount with a lower level of the access authorization level of a user. Lofgren teaches an image information modification component modifies the variable value by a smaller amount with a higher level of access authorization of a user, and modifies the variable value by a larger amount with a lower level of the access authorization level of a user (col. 9, lines 1-25). Lofgren which uses a granular access method to protected content teaches that users must meet certain authentication levels in order to access such content. Lofgren uses bits in the watermarking to differentiate between access levels. There is obvious some type of an order whereby only users with the most clearance can access all the content. On the contrary, users with low clearance can only access the less classified content. Such a teaching, obviously benefits Oki system in which really the only two types of protection for the content is the number of copies and number of pages printed. The use of known technique to improve similar devices in the same way is obvious to one of ordinary skill in the art. The claim would have been obvious because the technique for improving watermarking copy prevention was part of the ordinary capabilities of a person of ordinary skill in the art at the time of the invention, in view of the teaching of granular user access levels in Lofgren.

As per claim 19, Oki is silent in disclosing an information reading unit which reads access authorization from a recording medium storing the access authorization of a user, and provides the read access authorization to said image information processing apparatus. Lofgren teaches an information reading unit which reads access authorization from a recording medium storing the access authorization of a user, and provides the read access authorization to said image information processing apparatus (col. 9, lines 42-44). Examiner relies upon the same rationale for combining the teachings of Lofgren with the teachings of Oki as a means to improve on the system of Oki as cited above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is

(571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am

- 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2431